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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,198	01/16/2004	Nobuyuki Tonegawa	00862.023404.	4895
5514 7590 11/20/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
RILEY, MARCUS T				
ART UNIT		PAPER NUMBER		
2625				
MAIL DATE		DELIVERY MODE		
11/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,198

Applicant(s)

TONEGAWA, NOBUYUKI

Examiner

MARCUS T. RILEY

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 07/09/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 28, 2008 has been entered.

Response to Amendment

2. This office action is responsive to applicant's remarks received on August 28, 2008. **Claims 1-11** remain pending.

Response to Arguments

3. Applicant's arguments with respect to amended **claims 1, 2, 9, 10 and 11** filed on December 27, 2007 have been fully considered but they are not persuasive.

A: Applicant's Remarks

In particular, by this amendment those claims have been amended to require that the first and second data are registered in the database concurrently but individually, wherein the control means selects only one of the first and second data. These features are supported by Fig. 1 of the drawings in which application data 121 and 123 and image data 122 and 124 are

registered concurrently but individually, and by Figs. 9 and 15 in which the image data is selected if the printing is designated as the output method, and Figs. 10 and 16 in which the application data is selected if the sending is designated as the output method.

In the Office Action it is asserted that the Motoyama technique, which merges two inputs and which outputs the merged image data using various output methods, corresponds to the features of the present invention. However, according to that Motoyama technique, the two data inputs are not registered individually since the two are merged. In addition, the Motoyama technique merely outputs both of the two data inputs, and thus does not select either of the two data images in accordance with the designated output method. In other words, the Motoyama reference fails to disclose or suggest the claimed invention having the above-characterized requirements.

The Ett patent also fails to disclose or suggest the claimed invention having those features, so that even if the two references were combined, such combination would not teach or suggest at least these patentable requirements of the amended independent claims.

For these reasons it is believed that the application is in condition for the issuance of a Notice of Allowance.

A: Examiner's Response

Applicant has amended claims 1 & 9-11 to require that the first and second data are registered in the database concurrently but individually, wherein the control means selects only one of the first and second data. These features are supported by Fig. 1 of the drawings in which

application data 121 and 123 and image data 122 and 124 are registered concurrently but individually, and by Figs. 9 and 15 in which the image data is selected if the printing is designated as the output method, and Figs. 10 and 16 in which the application data is selected if the sending is designated as the output method.

Examiner disagrees with Applicant assertion that the figures show how the first and second data are registered in the database concurrently. It is not clear from the figures or within in the language of the specification that first and second data are registered in the database concurrently. Examiner understands the figures referenced by the applicant to show that first and second data are in the database simultaneously, but there is nothing in the figures or specification to show, explain or suggest that the first and second data are registered in the database "concurrently". Page 2, paragraph 0015 of applicants specification specifically states...
"registration-means for registering the first and second data in a database in correspondence with a specific index." It is understood that the first and second data are registered in the data base but there is nothing in the specification that specifically states that it happens at the same time.

Motoyama '836 discloses wherein the first and second data are registered in the database concurrently but individually (*"As indicated above, selection of a registered image is analogous to the selection of any other image to be merged. For example, returning to FIG. 6, a merge request is made (block 102) and then the merge destination is selected (block 104). By way of example, the first input read (block 106) may be a copy, and the second input read (block 108) may be a registered image, as selected from the registered image selection menu of FIG. 8. Thereafter, the merge operation is executed (block 110) and the merged document is transmitted (block 112)."* page 4, paragraph 0055). Here, according to that Motoyama, the two data inputs are registered individually and then they are merged. In addition, Motoyama selects either of the two data images in accordance with the

designated output method and from the registered image selection menu of FIG. 8. In other words, the Motoyama reference does not fail to disclose or suggest the claimed invention.

The Motoyama alone or in combination with Ett, does not fail to disclose or suggest the applicant's claimed invention. Thus, the two references were combined does disclose, teach or suggests the limitations of the amended independent claims.

Because each one of the other independent claims has been amended in the same manner as Claim 1, the application is not condition for allowance.

Claim Objections

4. The previous claim 1 objection is withdrawn in light of the applicant's amendment.
5. The following is a quotation of 37 CFR 1.75(d)(1):

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

6. **Claims 1 & 9-11** are objected to under 37 CFR 1.75(d)(1), as failing to conform to the invention as set forth in the remainder of the specification. **Claims 1 & 9-11** states in part *"wherein the first and second data are registered in the database concurrently but individually"*. Applicant relies on Fig. 1 of the drawings in which Applicant argues that the application data 121 and 123 and image data 122 and 124 are registered concurrently but individually, and by Figs. 9 and 15 in which the applicant argues that the image data is selected if the printing is designated as the output method, and Figs. 10 and 16 in which the application data is selected if the sending is designated as the output method. It is not clear from the figures or within in the

language of the specification that the first and second data are registered in the database concurrently. Examiner understands the figures referenced by the applicant to show that first and second data are in the database simultaneously but there is nothing in the figures to show that they register in the database "concurrently".

7. Even though the claimed subject matter did not appear to have adequate support in the Applicant's specification, the Examiner has tried to interpret the claims, as best the Examiner can ascertain, to develop an appropriate prior art rejection in the interests of compact prosecution. If any interpretation of the Examiner's is considered incorrect or off-base, the Examiner invites the Applicant to show the portions of the Applicant's specification which give a more proper interpretation of the claimed subject matter.

Claim Rejections - 35 USC § 101

(The previous claim rejection is withdrawn in light of the applicant's amendment.)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1, 6, 7 & 9-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US 2002/0030836 A1 hereinafter, Motoyama '836) in combination with Ett (US 5,227,893 hereinafter, Ett '893).

Regarding claim 1; Motoyama '836 discloses an image processing apparatus comprising: first input means for inputting first data created by predetermined application software (*"The multi-function machine 10 then provides a prompt to read the first input (block 106). As before, the prompt may be provided on LCD 36, or on the monitor 82 of host computer 80. The first input may be image data from host computer 80, scanned image data, or stored facsimile image data."* page 3, paragraph 0037);

second input means for inputting second data converted into image data of a predetermined format on the basis of the first data (*"The multi-function machine 10 then provides a prompt to read the second input (block 108). The prompt may be provided on LCD 36, or on the monitor 82 of host computer 80. The second input may be any of a number of classes of image data, as was the case with the first input."* page 3, paragraph 0038);

registration means for registering the first and second data in a database in correspondence with a specific index (*"...returning to FIG. 6, a merge request is made (block 102) and then the merge destination is selected (block 104). By way of example, the first input read (block 106) may be a copy, and the second input read (block 108) may be a registered image, as selected from the registered image selection menu of FIG. 8."* Page 4, Paragraph 0055);

wherein the first and second data are registered in the database concurrently but individually (*"As indicated above, selection of a registered image is analogous to the selection of any other image to be merged. For example, returning to FIG. 6, a merge request is made (block 102) and then the merge destination is selected (block 104). By way of example, the first input read (block 106) may be a copy, and the second input read (block 108) may be a registered image, as selected from the registered image selection menu of FIG. 8. Thereafter, the merge operation is executed (block 110) and the merged document is transmitted (block 112)."* page 4, paragraph 0055);

output means for outputting either of the first and second data which are registered in the database (*"the merged image data is routed to any of a number of locations including the printer, the host computer, DRAM, an optional disk, or the facsimile output."* page 3, paragraph 0040);

designation means for designating an output method by said output means from a plurality of output methods (*"In accordance with the present invention, the merged image data may be conveyed to any of a number of user selectable output destinations."* page 2, paragraph 0035);

and control means for selecting either of the first and second data corresponding to the input by said input means on the basis of a kind of the output method designated by said designation means from the database and causing said output means to output the selected data in accordance with the designated output method (*"The merge instruction may be executed in any of a number of manners. For instance, the first input first input may be fax image data which is stored in DRAM 58. The second input may be image data from host computer 80. CPU 42 will consider each pixel from the respective inputs and perform the required logical operation. The merged image data output from the logical operation may be conveyed to DRAM 46 or storage device 74 until the merge operation is completed. Thereafter, the CPU 42 uses the stored user-selected destination to create a route command. Thus, if the merged image data of the present example is to be routed to the facsimile output, then the CPU 42 would provide instructions to move the stored image data over bus 44 through interface controller 56 into fax processor 60."* page 3, paragraph 0046). See also (*"In sum, the machine 10 may include a copier, a scanner, a printer, and a facsimile apparatus. Selection of the individual functions may be achieved through a control panel 34."* page 2, paragraph 0026) and see (*"Finally, the merged data is transmitted to the user selectable destination (block 112). The destination was previously determined at block 104. Thus, the merged image data is routed to any of a number of locations including the printer, the host computer, DRAM, an optional disk, or the facsimile output."* page 2, paragraph 0040).

Motoyama '836 does not expressly disclose index input means for inputting the specific index.

Ett '893 discloses index input means for inputting the specific index (*"It is another object of the invention to recover the Pseudo Bar Code information, converting it to standard computer coded data suitable for re-routing the facsimile or image message, or for indexing..."* column 1, lines 16-20);

Motoyama '836 and Ett '893 are combinable because they are from same field of endeavor of image processing apparatuses (*"It is another object of the present invention to incorporation of said code pattern into the image portion of a facsimile or other image transmission in such a manner as to be transparent to the system, the network, and users."* Ett '893 at column 2, lines 25-29).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify image processing unit as taught by Motoyama '836 by adding index input means for inputting the specific index as taught by Ett '893. The motivation for doing so would have been to permit the embedding of data needed for indexing, or further routing, within the image in machine readable form, which is transparent to the users. (*"This invention combines some of the attributes of commonly used Bar Codes with facsimile in a manner such as to permit the embedding of data needed for indexing, or further routing, within the image in machine readable form, which is transparent to the users."* Ett '893 at column 2, lines 13-17). Therefore, it would have been obvious to combine Motoyama '836 with Ett '893 to obtain the invention as specified in claim 1.

Regarding claim 6; Motoyama '836 discloses wherein said output means includes said printing means, and when the output method designated by said designation means is printed by said printing means, said control means so controls as to select the second data and cause said printing means to print an image based on the second data (*"The instructions of the routine provide a prompt for the destination of the merged data. This prompt is sent by bus 44 through interface controller 1 (52) or through interface controller 2, depending upon where the merge request originated from. In the case of an instruction routed through interface controller 1, a prompt is provided on LCD 36. For instance, a suitable prompt would be "Enter Merged Data Destination". The data destination would then be entered through the use of one of the control panel 34 keys, for instance, the "print" key, or by*

using the cursor control keys 35 on the control panel 34. An analogous procedure is undertaken in the case of an instruction routed through interface controller 2. In this instance, the prompt is provided on computer monitor 82 of host computer 80. The data destination would then be entered through the keyboard or mouse associated with the host computer. In either embodiment, the destination is read and stored in one of the memory devices (DRAM 46 or storage device 74). **Subsequently, prompts are provided in an analogous manner for the first input and the second input. The first and second inputs are read and stored in one of the memory devices. Afterwards, the merge instruction is executed. The merge instruction may be executed in any of a number of manners. For instance, the first input may be fax image data which is stored in DRAM 58. The second input may be image data from host computer 80.**" page 3, paragraphs 0043-0046).

Regarding claim 7; Motoyama '836 discloses wherein the apparatus further comprises transmission means for transmitting data as one of said output means, and when the output method designated by said designation means is transmission by said transmission means, said control means so controls as to cause said transmission means to transmit the first data ("*...the merged data is transmitted to the user selectable destination (block 112). The destination was previously determined at block 104. Thus, the merged image data is routed to any of a number of locations including the printer, the host computer, DRAM, an optional disk, or the facsimile output. The particular execution of these instructions on the multi-function machine 10 is more fully appreciated with reference to FIG. 3. The merge request is received by CPU 42 via bus 44 through either interface controller 1 (52), in the case of a request from the control panel 34, or through interface controller 2 (54), in the case of a request from the host computer 80.*" page 3, paragraphs 0040-0041).

Regarding claim 9; Motoyama '836 discloses an image processing method comprising: a first input step of inputting first data created by predetermined application software ("*The multi-function machine 10 then provides a prompt to read the first input (block 106). As before, the prompt may be provided on LCD 36, or on the monitor 82 of host computer 80. The first input may be image data from host computer 80, scanned image data, or stored facsimile image data.*" page 3, paragraph 0037);

a second input step of inputting second data converted into image data of a predetermined format on the basis of the first data ("*The multi-function machine 10 then provides a prompt to read the second input*

(block 108). The prompt may be provided on LCD 36, or on the monitor 82 of host computer 80. The second input may be any of a number of classes of image data, as was the case with the first input." page 3, paragraph 0038);

a registration step of registering the first and second data in a database in correspondence with a specific index (*"As indicated above, selection of a registered image is analogous to the selection of any other image to be merged. For example, returning to FIG. 6, a merge request is made (block 102) and then the merge destination is selected (block 104). By way of example, the first input read (block 106) may be a copy, and the second input read (block 108) may be a registered image, as selected from the registered image selection menu of FIG. 8. Thereafter, the merge operation is executed (block 110) and the merged document is transmitted (block 112).*" page 4, paragraph 0055);

wherein the first and second data are registered in the database concurrently but individually (*"As indicated above, selection of a registered image is analogous to the selection of any other image to be merged. For example, returning to FIG. 6, a merge request is made (block 102) and then the merge destination is selected (block 104). By way of example, the first input read (block 106) may be a copy, and the second input read (block 108) may be a registered image, as selected from the registered image selection menu of FIG. 8. Thereafter, the merge operation is executed (block 110) and the merged document is transmitted (block 112).*" page 4, paragraph 0055);

a designation step of designating an output method of the data registered in the database from a plurality of output methods (*"In accordance with the present invention, the merged image data may be conveyed to any of a number of user selectable output destinations.*" page 2, paragraph 0035);

and an output step of selecting either of the first and second data corresponding to the input by said input means on the basis of a kind of the output method designated from the database in the designation step, and outputting the selected data in accordance with the designated output method (*"The merge instruction may be executed in any of a number of manners. For instance, the first input first input may be fax image data which is stored in DRAM 58. The second input may be image data from host computer 80. CPU 42 will consider each pixel from the respective inputs and perform the required logical operation. The merged image data output from the logical operation may be conveyed to DRAM 46 or storage device 74 until the merge operation is completed. Thereafter, the CPU 42 uses the stored user-selected destination to create a route command. Thus, if*

the merged image data of the present example is to be routed to the facsimile output, then the CPU 42 would provide instructions to move the stored image data over bus 44 through interface controller 56 into fax processor 60." page 3, paragraph 0046). See also ("*In sum, the machine 10 may include a copier, a scanner, a printer, and a facsimile apparatus. Selection of the individual functions may be achieved through a control panel 34.*" page 2, paragraph 0026) and see ("*Finally, the merged data is transmitted to the user selectable destination (block 112). The destination was previously determined at block 104. Thus, the merged image data is routed to any of a number of locations including the printer, the host computer, DRAM, an optional disk, or the facsimile output.*" page 2, paragraph 0040).

Motoyama '836 does not expressly disclose an index input step of inputting the specific index.

Ett '893 discloses an index input step of inputting the specific index ("*It is another object of the invention to recover the Pseudo Bar Code information, converting it to standard computer coded data suitable for re-routing the facsimile or image message, or for indexing...*" column 1, lines 16-20);

Motoyama '836 and Ett '893 are combinable because they are from same field of endeavor of image processing apparatuses ("*It is another object of the present invention to incorporation of said code pattern into the image portion of a facsimile or other image transmission in such a manner as to be transparent to the system, the network, and users.*" Ett '893 at column 2, lines 25-29).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify image processing unit as taught by Motoyama '836 by adding index input means for inputting the specific index as taught by Ett '893. The motivation for doing so would have been to permit the embedding of data needed for indexing, or further routing, within the image in machine readable form, which is transparent to the users ("*This invention combines some of the attributes of commonly used Bar Codes with facsimile in a manner such as to permit the embedding of data needed for indexing, or further routing, within the image in machine readable form, which is transparent to the users.*" Ett '893 at column 2, lines

13-17). Therefore, it would have been obvious to combine Motoyama '836 with Ett '893 to obtain the invention as specified in claim 1.

Regarding claim 10; Motoyama '836 discloses a program which causes a computer to execute a first input step of inputting first data created by predetermined application software (*"The multi-function machine 10 then provides a prompt to read the first input (block 106). As before, the prompt may be provided on LCD 36, or on the monitor 82 of host computer 80. The first input may be image data from host computer 80, scanned image data, or stored facsimile image data."* page 3, paragraph 0037);

a second input step of inputting second data converted into image data of a predetermined format on the basis of the first data (*"The multi-function machine 10 then provides a prompt to read the second input (block 108). The prompt may be provided on LCD 36, or on the monitor 82 of host computer 80. The second input may be any of a number of classes of image data, as was the case with the first input."* page 3, paragraph 0038);

a registration step of registering the first and second data in a database in correspondence with a specific index (*"...returning to FIG. 6, a merge request is made (block 102) and then the merge destination is selected (block 104). By way of example, the first input read (block 106) may be a copy, and the second input read (block 108) may be a registered image, as selected from the registered image selection menu of FIG. 8."* Page 4, Paragraph 0055);

wherein the first and second data are registered in the database concurrently but individually (*"As indicated above, selection of a registered image is analogous to the selection of any other image to be merged. For example, returning to FIG. 6, a merge request is made (block 102) and then the merge destination is selected (block 104). By way of example, the first input read (block 106) may be a copy, and the second input read (block 108) may be a registered image, as selected from the registered image selection menu of FIG. 8. Thereafter, the merge operation is executed (block 110) and the merged document is transmitted (block 112)."* page 4, paragraph 0055);

a designation step of designating an output method of the data registered in the database from a plurality of output methods (*"In accordance with the present invention, the merged image data may be conveyed to any of a number of user selectable output destinations."* page 2, paragraph 0035);

and an output step of selecting either of the first and second data corresponding to the input by said input means on the basis of a kind of the output method designated from the database in the designation step and outputting the selected data in accordance with the designated output method (*"The merge instruction may be executed in any of a number of manners. For instance, the first input first input may be fax image data which is stored in DRAM 58. The second input may be image data from host computer 80. CPU 42 will consider each pixel from the respective inputs and perform the required logical operation. The merged image data output from the logical operation may be conveyed to DRAM 46 or storage device 74 until the merge operation is completed. Thereafter, the CPU 42 uses the stored user-selected destination to create a route command. Thus, if the merged image data of the present example is to be routed to the facsimile output, then the CPU 42 would provide instructions to move the stored image data over bus 44 through interface controller 56 into fax processor 60."* page 3, paragraph 0046). See also (*"In sum, the machine 10 may include a copier, a scanner, a printer, and a facsimile apparatus. Selection of the individual functions may be achieved through a control panel 34."* page 2, paragraph 0026) and see (*"Finally, the merged data is transmitted to the user selectable destination (block 112). The destination was previously determined at block 104. Thus, the merged image data is routed to any of a number of locations including the printer, the host computer, DRAM, an optional disk, or the facsimile output."* page 2, paragraph 0040).

Motoyama '836 does not expressly disclose an index input step of inputting the specific index.

Ett '893 discloses an index input step of inputting the specific index (*"It is another object of the invention to recover the Pseudo Bar Code information, converting it to standard computer coded data suitable for re-routing the facsimile or image message, or for indexing..."* column 1, lines 16-20).

Motoyama '836 and Ett '893 are combinable because they are from same field of endeavor of image processing apparatuses (*"It is another object of the present invention to incorporation of said*

code pattern into the image portion of a facsimile or other image transmission in such a manner as to be transparent to the system, the network, and users.” Ett ‘893 at column 2, lines 25-29).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify image processing unit as taught by Motoyama ‘836 by adding an index input step of inputting the specific index as taught by Ett ‘893.

The motivation for doing so would have been to permit the embedding of data needed for indexing, or further routing, within the image in machine readable form, which is transparent to the users. (*“This invention combines some of the attributes of commonly used Bar Codes with facsimile in a manner such as to permit the embedding of data needed for indexing, or further routing, within the image in machine readable form, which is transparent to the users.”* Ett ‘893 at column 2, lines 13-17).

Therefore, it would have been obvious to combine Motoyama ‘836 with Ett ‘893 to obtain the invention as specified in claim 1.

Regarding claim 11; Motoyama ‘836 discloses a program stored on a computer-readable storage medium which stores a program for causing a computer to execute a first input step of inputting first data created by predetermined application software (*“The routing destination is where the merged image data is sent. For instance, the merged image data may be sent to the printer for printing, to the host computer, to DRAM, to a storage device, or to the facsimile, as to be more fully described below. The multi-function machine 10 then provides a prompt to read the first input (block 106). As before, the prompt may be provided on LCD 36, or on the monitor 82 of host computer 80. The first input may be image data from host computer 80, scanned image data, or stored facsimile image data.”* page 3, paragraphs 0036-0037);

a second input step of inputting second data converted into image data of a predetermined format on the basis of the first data (*“The multi-function machine 10 then provides a prompt to read the second input (block 108). The prompt may be provided on LCD 36, or on the monitor 82 of host computer 80. The second input may be any of a number of classes of image data, as was the case with the first input.”* page 3, paragraph 0038);

a registration step of registering the first and second data in a database in correspondence with a specific index (*"...returning to FIG. 6, a merge request is made (block 102) and then the merge destination is selected (block 104). By way of example, the first input read (block 106) may be a copy, and the second input read (block 108) may be a registered image, as selected from the registered image selection menu of FIG. 8."* page 4, paragraph 0055);

wherein the first and second data are registered in the database concurrently but individually See also (*"As indicated above, **selection of a registered image** is analogous to the selection of any other image to be merged. For example, returning to FIG. 6, a merge request is made (block 102) and then the merge destination is selected (block 104). By way of example, **the first input read (block 106) may be a copy, and the second input read (block 108) may be a registered image, as selected from the registered image selection menu of FIG. 8.** Thereafter, the merge operation is executed (block 110) and the merged document is transmitted (block 112)."* page 4, paragraph 0055);

a designation step of designating an output method of the data registered in the database from a plurality of output methods (*"In accordance with the present invention, **the merged image data may be conveyed to any of a number of user selectable output destinations.**"* page 2, paragraph 0035);

and an output step of selecting either of the first and second data corresponding to the input by said input means on the basis of a kind of the output method designated from the database in the designation step and outputting the selected data in accordance with the designated output method (*"The merge instruction may be executed in any of a number of manners. For instance, the first input first input may be fax image data which is stored in DRAM 58. The second input may be image data from host computer 80. CPU 42 will consider each pixel from the respective inputs and perform the required logical operation. The merged image data output from the logical operation may be conveyed to DRAM 46 or storage device 74 until the merge operation is completed. Thereafter, the CPU 42 uses the stored user-selected destination to create a route command. Thus, if the merged image data of the present example is to be routed to the facsimile output, then the CPU 42 would provide instructions to move the stored image data over bus 44 through interface controller 56 into fax processor 60."* page 3, paragraph 0046). See also (*"In sum, the machine 10 may include a copier, a scanner, a printer, and a facsimile apparatus. Selection of the individual functions may be achieved through a control panel 34."* page 2, paragraph 0026) and see (*"Finally,*

the merged data is transmitted to the user selectable destination (block 112). The destination was previously determined at block 104. Thus, the merged image data is routed to any of a number of locations including the printer, the host computer, DRAM, an optional disk, or the facsimile output." page 2, paragraph 0040).

Motoyama '836 does not expressly disclose an index input step of inputting the specific index.

Ett '893 discloses an index input step of inputting the specific index (*"It is another object of the invention to recover the Pseudo Bar Code information, converting it to standard computer coded data suitable for re-routing the facsimile or image message, or for indexing..."* column 1, lines 16-20).

Motoyama '836 and Ett '893 are combinable because they are from same field of endeavor of image processing apparatuses (*"It is another object of the present invention to incorporation of said code pattern into the image portion of a facsimile or other image transmission in such a manner as to be transparent to the system, the network, and users."* Ett '893 at column 2, lines 25-29).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify image processing unit as taught by Motoyama '836 by adding an index input step of inputting the specific index as taught by Ett '893.

The motivation for doing so would have been to permit the embedding of data needed for indexing, or further routing, within the image in machine readable form, which is transparent to the users (*"This invention combines some of the attributes of commonly used Bar Codes with facsimile in a manner such as to permit the embedding of data needed for indexing, or further routing, within the image in machine readable form, which is transparent to the users."* Ett '893 at column 2, lines 13-17).

Therefore, it would have been obvious to combine Motoyama '836 with Ett '893 to obtain the invention as specified in claim 1.

10. **Claims 2-5 & 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama '836 in combination with Ett '893.

Regarding claim 2; Motoyama '836 as modified does not expressly disclose where the apparatus further comprises printing means for printing an image obtained by synthesizing information representing the index and the second data input by said second input means, and said index input means inputs the information representing the index by reading, by a reading device, the image which is obtained by synthesizing the information representing the index and the data input by said second input means and is printed by said printing means.

Ett '893 discloses where the apparatus further comprises printing means for printing an image obtained by synthesizing the information representing the index and the second data input by said second input means, and said index input means inputs the information representing the index by reading, by a reading device, the image which is obtained by synthesizing the information representing the index and the data input by said second input means and is printed by said printing means (*"The initial or start character enables the pseudo bar code decode module 52 to determine the density used. The decoded ASCII characters are then used to define the routing, destination, or storage index, thus permitting incoming facsimile messages to be handled without an operator. In an alternate, but less preferred embodiment, the black and white stripe of the pseudo bar code itself is used to define routing or indexing procedures without translation to the alphanumeric character stream. The received facsimile messages can be displayed on the display 18, or printed on the printer 22, or may be sent to a Host computer via host connections 30 and host communication line 56, or via the facsimile modem 28 and the PSTN 56 to another facsimile system, with the same or new imbedded routing/indexing information."* column 5, lines 56-67 thru column 6, lines 1-3).

Motoyama '836 and Ett '893 are combinable because they are from same field of endeavor of image processing apparatuses (*"It is another object of the present invention to incorporation of said*

code pattern into the image portion of a facsimile or other image transmission in such a manner as to be transparent to the system, the network, and users.” Ett ‘893 at column 2, lines 25-29).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify image processing unit as taught by Motoyama ‘836 by adding where the apparatus further comprises printing means for printing an image obtained by synthesizing the information representing the index and the second data input by said second input means, and said index input means inputs the information representing the index by reading, by a reading device, the image which is obtained by synthesizing the information representing the index and the data input by said second input means and is printed by said printing means as taught by Ett ‘893.

The motivation for doing so would have been to permit the embedding of data needed for indexing, or further routing, within the image in machine readable form, which is transparent to the users. (*“This invention combines some of the attributes of commonly used Bar Codes with facsimile in a manner such as to permit the embedding of data needed for indexing, or further routing, within the image in machine readable form, which is transparent to the users.”* Ett ‘893 at column 2, lines 13-17).

Therefore, it would have been obvious to combine Motoyama ‘836 with Ett ‘893 to obtain the invention as specified in claim 1.

Regarding claim 3; Ett ‘893 discloses where the information representing the index is expressed by a barcode (*“FIG. 3A shows a typical string of bar codes in code 39, with a start character 78, data characters 80, a check data character 82, and a stop character 84. The start 78 and stop 84 characters are identical and contain information needed to define the widths of the bars and spaces in the ensuing code patterns.”* column 6, lines 34-39).

Regarding claim 4; Ett ‘893 discloses where the information representing the index is expressed by a character string (*“FIG. 3A shows a typical string of bar codes in code 39, with a start character 78,*

data characters 80, a check data character 82, and a stop character 84. The start 78 and stop 84 characters are identical and contain information needed to define the widths of the bars and spaces in the ensuing code patterns.” column 6, lines 34-39).

Regarding claim 5; Ett ‘893 discloses where the information representing the index is expressed by each character spacing in a predetermined character string (“*The initial or start character enables the pseudo bar code decode module 52 to determine the density used. The decoded ASCII characters are then used to define the routing, destination, or storage index...*” column 5, lines 56-59). See also (“*FIG. 3A shows a typical string of bar codes in code 39, with a start character 78, data characters 80, a check data character 82, and a stop character 84. The start 78 and stop 84 characters are identical and contain information needed to define the widths of the bars and spaces in the ensuing code patterns.*” column 6, lines 34-39).

Regarding claim 8; Ett ‘893 discloses where the database is constructed by a terminal connected via a network (“*It is another object of the present invention to incorporate of said code pattern into the image portion of a facsimile or other image transmission in such a manner as to be transparent to the system, the network, and users.*” column 2, lines 25-29).

Examiner Notes

11. The Examiner cites particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully considers the references in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or as disclosed by the Examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCUS T. RILEY whose telephone number is (571)270-1581. The examiner can normally be reached on Monday - Friday, 7:30-5:00, est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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